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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/384,646 08/27/99 BIRNIE

K 1-1-1-1

EXAMINER

WM02/0928

DOCKET ADMINISTRATOR RM 3C-512  
LUCENT TECHNOLOGIES INC  
600 MOUNTAIN AVENUE  
PO BOX 636  
MURRAY HILL NJ 07974-0636

PEREZ GUTIERREZ, R

ART UNIT

PAPER NUMBER

2683

DATE MAILED:

09/28/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/384,646

Applicant(s)  
Birnie et al.

Examiner  
Rafael Perez-Gutierrez

Art Unit  
2683



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on Aug 27, 1999

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 1-18 is/are pending in the application

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1-18 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirements

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on Aug 27, 1999 is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some\* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6 and 7

20) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Information Disclosure Statement*

1. The information disclosure statements submitted on October 7, 1999 and January 17, 2001 have been considered by the Examiner and made of record in the application file.

### *Drawings*

2. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.
3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character “**210**” has been used to designate two different steps in **figure 3**. Correction is required either in the figure, specification, or both.

### *Claim Objections*

4. **Claims 1, 8, 15, and 17** are objected to because of the following informalities:
  - a) On **line 1** of **claims 1 and 8**, replace “cell” with --call--; and
  - b) On **line 4** of **claims 15 and 17**, insert --and-- after “identifiers;”.

Appropriate correction is required.

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***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the Examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the Examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. **Claims 1, 8, 15, and 17** are rejected under 35 U.S.C. 103(a) as being unpatentable over

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**Mizikovsky (U.S. Patent # 5,255,307) in view of Bartle et al. (U.S. Patent # 6,018,655).**

Consider **claims 1, 8, 15, and 17**, Mizikovsky clearly shows and discloses a mobile station 18 (wireless terminal) and a method for alerting a mobile station (wireless terminal) user of a handoff of a cell from a first communication service station 12 to a second communication service station 25 (figure 2), said mobile station 18 (wireless terminal) and method comprising:

a transceiver 32 (receiver) that receives a handoff indicating message (figure 8, column 9 lines 28-31 and 45-57, and claim 7);

a memory 44 containing System Identification Data (SID<sub>s</sub>) (acceptable identifier) (figure 8 and column 13 lines 50-54); and

a microprocessor 60 (processor) that determines if a received System Identification Data (SID<sub>r</sub>) (received identifier) of the second communication service station 25 match the stored System Identification Data (SID<sub>s</sub>) (acceptable identifier) (figure 8, column 13 lines 50-54, and column 14 lines 26-32) and activates a visual status indicator 48 during the call (abstract and column 3 lines 41-45) if the received System Identification Data (SID<sub>r</sub>) (received identifier) does not match the stored System Identification Data (SID<sub>s</sub>) (acceptable identifier) (abstract, column 3 line 58 - column 4 line 8, and column 13 lines 54-59).

Although Mizikovsky does not specifically discloses that the memory 44 contains a collection of acceptable identifiers (i.e., a plurality of SID's), it would have been clearly obvious to a person of ordinary skill in the art at the time the invention was made to include a plurality of SID's in the memory 44 of Mizikovsky, since Mizikovsky clearly disclose that the status

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indicator 48 of the mobile station (wireless terminal) is selectively controlled as the mobile station moves through service cells that are serviced by **different providers** (e.g., having different SID's) (column 3 lines 41-45).

However, Mizikovsky only disclose that the status indicator 48 outputs a visual indication to the user of a status change, and therefore, fails to disclose that an audible or a vibrating indication or alert to the user is outputted by the status indicator 48.

Bartle et al. clearly show and disclose a cellular telephone 10 (wireless terminal) and a method for indicating to a user of an imminent inter-system handoff in which the cellular telephone 10 (wireless terminal) provides a visual, vibrating, or audible alert to the user upon determining that an inter-system handoff is imminent (figure 1 and column 9 lines 38-58).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to further modify the teachings of Mizikovsky with the teachings of Bartle et al. to provide additional alerting means, such as audible or vibrating alerts, when a inter-system handoff is imminent in order to enable the user to be aware of the mobile telephone status (i.e., roaming) without having the need to constantly look at a display of the mobile telephone to know the current status of the telephone, specially when the user is currently on a telephone call.

7. **Claims 2-7, 9-14, 16, and 18** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Mizikovsky (U.S. Patent # 5,255,307)** in view of **Bartle et al. (U.S. Patent # 6,018,655)**, and further in view of **Son et al. (U.S. Patent # 6,201,957 B1)**.

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Consider **claims 2, 6, 7, 9, 13, 14, 16, and 18, and as applied to claims 1, 8, 15, and 17 above**, Mizikovsky as modified by Bartle et al. clearly discloses the claimed invention except that the call is automatically terminated, by means of the processor, after producing the vibrating or audible alert if a call continuation indication is not received.

Son et al. clearly show and disclose a system and method for implementing flexible calling plans in which when a subscriber moves from a home region to a roaming region during a call, the subscriber is alerted and provide with four options to terminate the call, wherein among said options, an option of terminating the call is included (figure 4, column 5 lines 58-64, and column 6 line 44 - column 7 line 9).

Although Son et al. disclose that the call is dropped when the handset is out of range of the home of the base station, it would have been obvious to a person of ordinary skill in the art at the time the invention to slightly modify the teachings of Son et al. to automatically terminate the call if the subscriber has not provided a call continuation indication (i.e., selection of an option) after, for example, a predetermined time or a user programmed time.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to further modify the combined teachings of Mizikovsky and Bartle et al. with the modified teachings of Son et al. in order to allow automatic termination of a call when the subscriber has failed to provided a call continuation indication, thereby protecting a subscriber of higher call charges when roaming to a visiting network.

Consider **claims 3-5 and 10-12, and as applied to claims 2 and 9 above**, although the

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combined teachings of Mizikovsky, Bartle et al., and Son et al. does not specifically disclose that the call continuation indication can be an utterance or an activation of key, the Examiner takes Official Notice that is notoriously well known in the art of mobile telephones to provide indications or commands to a mobile telephone via speech (i.e., an utterance) or manually (i.e., activation of a key) using information provided in a display of the mobile telephone.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to further modify the combined teachings of Mizikovsky, Bartle et al., and Son et al. with well known teachings in the art of mobile telephones in order to provide an indication or command to the mobile telephone via speech (i.e., an utterance) or manually (i.e., activation of a key).

### *Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

Gallant et al. (U.S. Patent # 5,802,468) disclose a system and method for identifying calling areas within a communication system;

Frager et al. (U.S. Patent # 6,018,652) disclose a cellular telephone system having mobile charging region and area based pricing method and apparatus;

Dufour (U.S. Patent # 6,073,010) discloses a system and method for restricting mobility



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to subscribers assigned to fixed subscription areas in a cellular telecommunications system;

Bridges et al. (U.S. Patent # 6,148,197) disclose an intelligent roaming system with over the air programming;

Schmidt (U.S. Patent # 6,208,872 B1) discloses a method and apparatus for inhibition of calls while roaming;

Andersson et al. (U.S. Patent # 6,230,017 B1) disclose geographical restriction in cellular telecommunications network;

Chow et al. (U.S. Patent # 6,243,572 B1) disclose a method and apparatus for billing a neighborhood cordless service.

9. Any response to this Office Action should be **faxed to (703) 872-9314 or mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**Hand-delivered responses** should be brought to

Crystal Park II  
2021 Crystal Drive  
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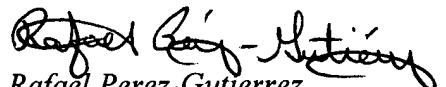
10. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rafael Perez-Gutierrez whose telephone number is (703) 308-

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8996. The Examiner can normally be reached on Monday-Thursday from 6:30am to 5:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, William G. Trost IV can be reached on (703) 308-5318. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700 or call customer service at (703) 306-0377.

  
Rafael Perez-Gutierrez  
R.P.G./rpg **RAFAEL PEREZ-GUTIERREZ**  
**PATENT EXAMINER**

September 25, 2001

  
**WILLIAM TROST**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2600**